

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1, 4, 12-13, 31-33 and 35-42 are pending in the application.

Claim 1 was amended to copy language from the preamble into the body of the claim.

Claim 7 was canceled and represented as new claim 35 so that all the claims from which it depends have a higher claim number.

Claim 8 was canceled and represented as new claim 36 so that all the claims from which it depends have a higher claim number.

Claim 10 was canceled and represented as new claim 37 so that all the claims from which it depends have a higher claim number.

Claim 11 was canceled and represented as new claim 38 so that all the claims from which it depends have a higher claim number.

Claim 12 was amended to move language within the claim. Also claim 12 was amended to add language that clarifies that the wear of the wire is less than the wear would be if the pigment contained a pigment other than calcium oxalate. Support these amendments is found, *inter alia*, at specification page 2, lines 15-16, and page 4, lines 24-27. Further, claim 12 was amended to clarify that the pigment may be in a coating color. Additional support for a pigment in a coating color is found, *inter alia*, at specification page 7 (last two lines) - page 8 (lines 1-2), and page 6 (lines 12-13).

Claim 14 was canceled and represented as new claim 39 so that all the claims from which it depends have a higher claim number.

Claim 15 was canceled and represented as new claim 40 so that all the claims from which it depends have a higher claim number.

Claim 16 was canceled and represented as new claim 41, so that all the claims from which it depends have a higher claim number.

Claim 34 originally depended from claim 15. However, claim 15 is now claim 40. Accordingly, claim 34 was canceled and represented as new claim 42, so that the claim from which it depends (claim 40) has a higher claim number.

The amendments are believed to introduce no new matter; accordingly, entry of these amendments is believed proper and is respectfully requested.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

The Rejections under 35 U.S.C. § 103(a)

I. Claims 12 and 32

Claims 12 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hampl Jr. (US 5,893,372) in view of Briskin et al (US 3,608,559) Simon (US 4,303,084, and Durocher (US 4,615,345) (herein Hampl, Briskin '559, Simon and Durocher, respectively). Applicant respectfully traverses this rejection and incorporates herein Applicant's previous arguments.

Claim 12 is independent. Claim 32 depends from claim 12.

In the advisory action, the Examiner states that the "preamble limitation 'of reducing wear of a coated, wood-free paper making wire' fails to distinguish the claimed invention from the invention claimed in the prior art because the preamble merely states the purpose of intended use of the invention."

Claim 12 refers to reducing wear in both the preamble and the body of the claim. The Examiner's attention is respectfully directed to the body of claim 12 in which the following text appears "thereby reducing wear of the coated, wood-free paper-making wire." Therefore, the body of the claims also contained the language that distinguished the art.

Additionally, Applicant has herein amended the body of claim 12 to further recite that the reduced wear is as compared to the wear of a paper-making wire that is used to make a coated, wood-free paper that contains a pigment other than said calcium oxalate in said coating pigment or in said coating color.

In reply to Applicant's argument that the cited art is non-analogous art related to cigarette paper making, the Examiner refers to his remarks concerning the preamble limitation. It is believed that the above amendments clarify that the body of the claim recites the desired language. Accordingly, it is believed that this rejection can be withdrawn.

II. Claims 1, 4, 7, 10, 11, 13-16, 31, 33 and 34

Claims 1, 4, 7, 10, 11, 13-16, 31, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hampl Jr. (U.S. 5,893,372) in view of Briskin et al (US

3,608,559 "), as evidenced by Briskin et al (U.S. 3,556,109), (herein Hampl, Briskin '559, and Briskin '109, respectively. Applicant respectfully traverses this rejection and incorporates herein Applicant's previous arguments.

The Examiner states that the preamble limitation "of reducing the combustion residue" fails to distinguish the claimed invention from the invention claimed in the prior art because the preamble merely states the purpose or intended use of the invention." Applicant respectfully disagrees.

For independent claim 1, Applicant notes that the body of the claim already recited that the paper has a reduced combustion residue when compared to that of a coated, wood-free paper that contains the same amount of a pigment other than calcium oxalate. In the interests of advancing prosecution, Applicant has amended claim 1 to move the ISO brightness and opacity language into the body of the claim.

With regard to independent claim 13, Applicant has amended the body of the claim to refer to calcium oxalate. The preamble of independent claim 13 is simply "Coated, wood-free paper." Claim 13 already contains the language " wherein said coated, wood-free paper has an ISO brightness of over 80% and an opacity of over 80%" in the body of the claim. Additionally, claim 13 refers to the reduced combustion residue in the body of the claim.

In reply to Applicant's argument that the cited art is non-analogous art related to cigarette paper making, the Examiner refers to his remarks concerning the preamble limitation. It is believed that the above amendments clarify that the body of the claim recites the desired language. Accordingly, it is believed that this rejection can be withdrawn.

III. Claim 8 (now claim 36)

Claims 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hampl Jr. (US 5,893,372) in view of Briskin et al (US 3,608,559) as evidenced by Briskin (US 3,556,109), as applied to claims 1, 4, 7(1,4,31) 10 (1,4,31), 11 (1,4,31), 13-16, 31, 33, and 34 above, and further in view of Rafton (US 1,934,638), herein Hampl, Briskin '559, Briskin '109 and Rafton, respectively). Applicant respectfully traverses this rejection and incorporates herein Applicant's previous arguments.

Claim 8 is now claim 36. Claim 36 depends from three alternative claims: independent claim 1, dependent claim 4 or dependent claim 31.

In the method of claim 36/1, the language of claim 36 states that the calcium oxalate is a monohydrate that has been ground and over 90% of the particles that are used are smaller than 2.3 μm and only 10% are smaller than 0.5 μm .

With regard to claim 36/4, claim 4 requires that the method of claim 36 result in a paper with an ISO brightness of 80% or more and an opacity of 80% or more.

With regard to claim 36/31, claim 31 requires that the method of claim 36 utilize calcium oxalate both in a coating pigment (from claim 1) and as a filler (claim 31).

The cited art simply does not suggest these combinations or motivate the artisan to reach the same.

Additionally, as discussed above, it is believed that the above amendments clarify that the body of independent claim 1 recites the language that distinguishes the art. Accordingly, it is believed that this rejection can be withdrawn.

IV. Claims 12 and 32

Claims 12 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hampl Jr. (US 5,893,372) in view of Briskin et al (US 3,608,559) as evidenced by Briskin (US 3,556,109), as applied to claims 1, 4, 7(1,4,31) 10 (1,4,31), 11 (1,4,31), 13-16, 31, 33, and 34 above, and further in view of Durocher (US 4,615,345), herein Hampl, Briskin '559, Briskin '109 and Durocher, respectively). Applicant respectfully traverses this rejection and incorporates herein Applicant's previous arguments.

Claim 32 depends from independent claim 12.

Claim 12 referred to "reducing wear of a coated, wood-free paper making wire" in the preamble. However, claim 12 also contained the phrase "thereby reducing wear of the coated, wood-free paper-making wire" in the body of the claim. Therefore, the body of the claims also contained the language that distinguished the art.

Additionally, Applicant has herein amended the body of claim 12 to further recite that the reduced wear is as compared to the wear of a paper-making wire that is used to make a coated, wood-free paper that contains a pigment other than said calcium oxalate in said coating pigment or in said coating color.

In reply to Applicant's argument that the cited art is non-analogous art related to cigarette paper making, the Examiner refers to his remarks concerning the preamble limitation. It is believed that the above amendments clarify that the body of the claim recites the desired language. Accordingly, it is believed that this rejection can be withdrawn.

V. Summary of the Rejections under 35 U.S.C. § 103(a)

Applicant respectfully asserts that each and every one of the rejections under 35 U.S.C. § 103(a) have been overcome by the remarks above. Accordingly, withdrawal of the rejections and allowance of the claims are respectfully requested.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Michele A. Cimbala
Michele A. Cimbala
Attorney for Applicant
Registration No. 33,851

Date: December 13, 2004

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

343741v1